PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Min-seop JEONG, et al.

Docket No: Q63312

Appln. No.: 09/901,486

Group Art Unit: 2666

Confirmation No.: 5180

Examiner: HOM, Shick C.

Filed: July 10, 2001

For: SYSTEM AND METHOD FOR ACCESSING NODE OF PRIVATE NETWORK

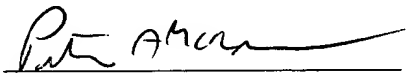
SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of $500.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,



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Date: July 5, 2006

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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

Table of Contents

I. REAL PARTY IN INTEREST

Based on the information supplied by the Appellant, and the best of Appellant's legal representative's knowledge, the real party in the interest is the assignee, SAMSUNG ELECTRONICS CO., LTD. The Assignment was recorded on September 28, 2001, at Reel 012213, Frame 0754.

II. RELATED APPEALS AND INTERFERENCES

To the best knowledge and belief of Appellant, the Assignee and the undersigned attorney, there are no other appeals or interferences before the Board of Appeals and Interferences ("the Board") that will directly affect or be affected by the Board's decision in the present Appeal.

III. STATUS OF CLAIMS

Claims 1-19 are all the claims pending in the application.

Claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. However, Appellant believes that the Examiner will remove this rejection in view of the Amendment filed January 3, 2006.

Claims 1-6 and 8-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wootton et al (U.S. Patent No. 6,128,298).

Claims 12-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Wootton et al in view of Maddalozzo, Jr. et al (U.S. Patent No. 5,878,218).

Claims 1-18 have been finally rejected.

Claim 7 would be allowable if rewritten in independent form to include the limitations of the base claim 6.

Claim 19 is allowed.

Claims 1-18 are the subject of this appeal.

IV. STATUS OF AMENDMENTS

All amendments to the claims have been entered. However, Appellant submits herewith an Amendment that rewrites allowable claim 7 in independent form to include the limitations of the base claim 6.

Appellant notes that claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Appellant believes that claim 1, as amended by the Amendment filed January 3, 2006, complies with the requirements of 35 U.S.C. § 112, second paragraph.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention relates to a system and method for accessing a node of a network, and more particularly to a system and method for accessing a node of a private network via the Internet. (Page 1, lines 3-5.) An embodiment of the invention is shown in Fig. 2. In order to gain access to a private network, the access system 40 includes input device 42, external port value assigning device 44, mapping table 46, address converting device 48, exchanging device 50, and outputting device 52. The external port value assigning device 44 collects information about respective internal nodes of the private networks and assigns separate external port values to the respective nodes. The external port values, which are assigned to the network nodes of the private networks as above, are exchanged by the exchanging device 50 and stored in the mapping table 46. When a certain node of one private network accesses another node of another private network by using the external port value of another node of another private network, the address converting device 48 converts the external port value into a corresponding private IP address and internal port value of another node of another private network. (Page 8, line 20 to page 9, line 13.)

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-6 and 8-11 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wootton et al (U.S. Patent No. 6,128,298).

Claims 12-18 are rejected under 35 U.S.C. § 103 as being unpatentable over Wootton et al in view of Maddalozzo, Jr. et al (U.S. Patent No. 5,878,218).

Appellant notes that claims 1-5 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Appellant believes that claim 1, as amended by the Amendment filed January 3, 2006, complies with the requirements of 35 U.S.C. § 112, second paragraph.

VII. ARGUMENT

Claims 1-6 and 8-11 are not anticipated by Wootton et al (U.S. Patent No. 6,128,298).

In a Response dated July 15, 2005, to the Office Action dated April 15, 2005, Appellant argued that Wooten et al does not anticipate claim 1 at least because Wootton et al does not teach the feature of claim 1 of:

> an address converting portion for converting the external port values into corresponding private IP addresses and internal port values when a network node of one private network accesses another network node of another private network by using the external port values of another network node of another private network.

Specifically, it was argued that there is no teaching in Wootton et al relating to converting external port values into corresponding private IP addresses and internal port values when a network node of one private network accesses another network node of another private network by using external port values of another network node of another private network.

In the Office Action dated October 3, 2005, the Examiner responded by arguing that Appellant's argument is not persuasive, "because col. 5 lines 16-55 which recite communications between the node 18 on the network 10 and node 20 on the network 14, see Fig. 1, using a

translation table maintained by the IP filter 12 acting as a gateway whereby the IP addresses and ports from the networks are substituted for the IP filter's IP address and ports clearly reads on converting external port values into IP addresses and internal port values when a node of the network accesses another node of another network as argued in pages 8 and 9 regarding claims 1 and 6 of the remark."

Appellant respectfully submits that the Examiner's remarks are directed to communications between a private network and a public network. That is, the Examiner refers to node 20 on network 14, but network 14 is clearly labeled a "PUBLIC NETWORK" (see Fig. 1). The teachings of Wootton et al cited by the Examiner clearly describe communications between "PUBLIC NETWORK" 14 and "PRIVATE NETWORK" 10. Such communications do not meet the requirement of the claim, "when a network node of one private network accesses another network node of another private network". At least for this reason, Appellant submits that claim 1 is not anticipated by Wootton et al.

In the Advisory Action of April 4, 2006, the Examiner states, "Wootton et al in Fig. 1 and in the abstract which recite providing Internet access to nodes of private networks clearly anticipate the nodes of private network 10 of Fig. 1 accessing another network node of another private network connected to the Internet 16." Appellant respectfully disagrees.

The Examiner appears to be arguing that Wootton teaches private networks connected to the Internet, and that these private networks are similar to private network 10 in that they communicate in symmetry with private network 10. There is simply no teaching in Wootton et

al that the nodes of private network 10 of Fig. 1 access another network node of another private network connected to the Internet 16. In fact, Wootton clearly teaches that there is no symmetry of operation between the private network 10 and the components of the Internet 16. For example, Wootton et al teaches: "The IP filter accepts no communications request from the public network 14. All communications between private nodes 18 and public nodes 20 are initiated by the private nodes 18." (Col. 5, lines 30-33.) Thus, even if one were to assume for the sake of argument that Wootton et al contemplates private networks other than private network 10 (which Appellant does not believe), there is no teaching about how such networks would communicate with private network 10. That is, Wootton et al explicitly teaches that the private network must initiate communications and that filter 12 will accept no communications requests from the public network 14. This is to provide security for the private network 10. Thus, Wootton et al does not provide teaching for a node of a private network accessing a node of another private network.

Similarly, Wootton et al does not teach, "exchanging the assigned external port value of a certain network node of a certain private network with the assigned external port value of another node of another private network, and storing the exchange external port value", as required by claim 6, and at least for this reason claim 6 is not anticipated by Wootton et..

Claims 12-18 are improperly rejected under 35 U.S.C. § 103 as being unpatentable over Wootton et al in view of Maddalozzo, Jr. et al (U.S. Patent No. 5,878,218).

Regarding the rejection of claims 12-18 under 35 U.S.C. § 103 as being unpatentable over Wootton et al in view of Maddalozzo, Jr. et al, it was argued in response to the Office Action dated April 15, 2005, that combining features ii-iv with feature i, of claim 12 would destroy the principle of operation upon which Wootton et al is based. In more detail, it was argued that Wootton et al is concerned with the security of private nodes in a private network (see the last sentence of the Abstract). Wootton et al teaches: "the IP filter 12 accepts no connection requests from the public network 14. All communications between private nodes 18 and public nodes 20 are initiated by the private nodes 18." (column 5, lines 30-43). Thus, Wootton et al teaches away from steps ii-iv of claim 12 of:

> ii) generating a webpage displaying node information of a private network, and liking the webpage to a global IP address;
>
> iii) accessing the webpage and the node information of the private network; and
>
> iv) accessing one of the network nodes of the private network based on the node information obtained in step iii).

In the Office Action dated October 3, 2005, the Examiner does not specifically respond to Appellant's argument that the combination proposed by the Examiner would destroy the principle of operation upon which Wootton et al is based. The Examiner merely asserts that the

secondary reference, Maddalozzo, Jr. et al, teaches "the feature of providing a web page displaying node information of the private network provides efficiency of accessing requested data file in the private network." Section 2143.01 of the MPEP provides, "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)." Also, "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

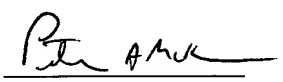
In the present case, modifying Wootton et al to perform operations ii-iv of claim 12 would change the operation of Wootton et al in a manner that Wootton et al explicitly teaches against. That is, Wootton et al explicitly states that "the IP filter 12 accepts no connection requests from the public network 14. All communications between private nodes 18 and public nodes 20 are initiated by the private nodes 18." (column 5, lines 30-43). Yet, the modification of Wootton et al proposed by the Examiner would result in the Wootton et al system operating in a manner that Wootton et al unequivocally seeks to avoid. Therefore, such a modification cannot render obvious the invention defined by claim 12.

The dependent claims of the application are patentable at least by virtue of their dependency.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37(a) and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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CLAIMS APPENDIX

CLAIMS 1-6 and 8-18 ON APPEAL:

1. A system, comprising:

an assigning portion for assigning external port values to network nodes respectively corresponding to the external port values based on information collected from the network nodes of a private network, and storing the assigned external port values;

an exchanging portion for exchanging the external port values of the respective network nodes of private networks; and

an address converting portion for converting the external port values into corresponding private IP addresses and internal port values when a network node of one private network accesses another network node of another private network by using the external port values of another network node of another private network.

2. The system as claimed in claim 1, wherein each of the network nodes is assigned at least one external port value.

3. The system as claimed in claim 2, wherein the external port value has an http communication protocol.

4. The system as claimed in claim 2, wherein the external port value has an FTP communication protocol.

5. The system as claimed in claim 2, wherein the external port value has a TELNET communication protocol.

6. A method, comprising the steps of:

a) assigning separate external port values to a plurality of network nodes of private networks based on information collected from the network nodes, and storing the assigned external port values;

b) exchanging the assigned external port value of a certain network node of a certain private network with the assigned external port value of another network node of another private network, and storing the exchanged external port value; and

c) converting the exchanged external port value into a corresponding private IP address and internal port value, enabling the certain network node of the certain private network to access another network node of another private network by using the external port value of another network node of another private network.

8. The method as claimed in claim 6, wherein each of the network nodes is assigned at least one external port value.

9. The method as claimed in claim 8, wherein the external port value has an http communication protocol.

10. The method as claimed in claim 8, wherein the external port value has an FTP communication protocol.

11. The method as claimed in claim 8, wherein the external port value has a TELNET communication protocol.

12. A method, comprising the steps of:

i) assigning external port values to network nodes based on an information collected from the network nodes and storing the information in a mapping table;

ii) generating a web page displaying node information of a private network, and linking the web page to a global IP address;

iii) accessing the web page and the node information of the private network; and

iv) accessing one of the network nodes of the private network based on the node information obtained in step iii).

13. The method as claimed in claim 12, wherein the node information of step iii) comprises an external port value.

14. The method as claimed in claim 12, wherein the web page of step ii) displays a screen containing icons for respective nodes of the private network.

15. The method as claimed in claim 14, wherein each node is accessed by selecting and clicking the icon representing the node.

16. The method as claimed in claim 12, wherein a private network provided with at least one global IP address performs step i).

17. The method as claimed in claim 12, wherein a certain network node of a certain external private network performs step iii).

18. The method as claimed in claim 17, wherein the certain network node of the certain external private network performs step iv).

EVIDENCE APPENDIX:

NONE

RELATED PROCEEDINGS APPENDIX

NONE